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OFFICE OF PETITIONS

In re Application of :
Lyle J. CHRISTIANSEN :
Application No. 10/662,244 :
Filed: September 16, 2003 :
Attorney Docket No.: :

ON PETITION

This is a decision on the petition filed February 16, 2006 under 37 CFR 1.181(a)(3) requesting that the Director exercise his supervisory authority and overturn the decision of the Director, Technology Center 3700 (Technology Center Director), dated February 8, 2006, which refused to compel the entry of the amendment after final filed May 26, 2005.

The petition to overturn the decision of the Technology Center Director dated February 8, 2006, is **DENIED**¹.

BACKGROUND

The instant application was filed September 16, 2003.

On February 9, 2005 a non-final Office action was mailed.

On March 1, 2005 a response was filed.

On May 18, 2005 a final Office action was mailed.

On May 26, 2005 an amendment after final Office action was filed.

On June 13, 2005 an Advisory Action denying entry of the amendment filed May 26, 2005 was mailed.

On June 23, 2005 a request for reconsideration of the Advisory Action of June 13, 2005 was filed.

On July 7, 2005 an Advisory Action denying entry of the amendment filed May 26, 2005 was mailed

On July 15, 2005 a petition requesting review of the Advisory Action of July 7, 2005 was filed.

On February 8, 2006 a decision dismissing the petition was mailed.

STATUTE, REGULATION, AND EXAMINING PROCEDURE

37 CFR 1.113 states:

(a) On the second or any subsequent examination or consideration by the examiner the rejection or other action may be made final, whereupon applicants, or for ex parte reexaminations filed under § 1.510, patent owner's reply is limited to appeal in the case of rejection of any claim (§ 1.191), or to amendment as specified in § 1.114 or § 1.116. Petition may be taken to the Commissioner in the case of objections or requirements not involved in the rejection of any claim (§ 1.181). Reply to a final rejection or action must comply with § 1.114 or paragraph (c) of this section. For final actions in an inter partes reexamination filed under § 1.913, see § 1.953.

(b) In making such final rejection, the examiner shall repeat or state all grounds of rejection then considered applicable to the claims in the application, clearly stating the reasons in support thereof.

(c) Reply to a final rejection or action must include cancellation of, or appeal from the rejection of, each rejected claim. If any claim stands allowed, the reply to a final rejection or action must comply with any requirements or objections as to form.

37 CFR 1.116 states:

(b) After a final rejection or other final action (§ 1.113) in an application or in an ex parte reexamination filed under § 1.510, or an action closing prosecution (§ 1.949) in an inter partes reexamination filed under § 1.913, amendments may be made canceling claims or complying with any requirement of form expressly set forth in a previous Office action. Amendments presenting rejected claims in better form for consideration on appeal may be admitted. The admission of, or refusal to admit, any amendment after a final rejection, a final action, an action closing prosecution, or any related proceedings will not operate to relieve the application or patent under reexamination from its condition as subject to appeal or to save the application from abandonment under

§ 1.135, or the reexamination from termination. No amendment can be made in an inter partes reexamination proceeding after the right of appeal notice under § 1.953 except as provided for in paragraph (d) of this section.

MPEP 706.07 states:

Before final rejection is in order a clear issue should be developed between the examiner and applicant. To bring the prosecution to as speedy conclusion as possible and at the same time to deal justly by both the applicant and the public, the invention as disclosed and claimed should be thoroughly searched in the first action and the references fully applied; and in reply to this action the applicant should amend with a view to avoiding all the grounds of rejection and objection. Switching from one subject matter to another in the claims presented by applicant in successive amendments, or from one set of references to another by the examiner in rejecting in successive actions claims of substantially the same subject matter, will alike tend to defeat attaining the goal of reaching a clearly defined issue for an early termination, i.e., either an allowance of the application or a final rejection.

While the rules no longer give to an applicant the right to "amend as often as the examiner presents new references or reasons for rejection," present practice does not sanction hasty and ill-considered final rejections. The applicant who is seeking to define his or her invention in claims that will give him or her the patent protection to which he or she is justly entitled should receive the cooperation of the examiner to that end, and not be prematurely cut off in the prosecution of his or her application. But the applicant who dallies in the prosecution of his or her application, resorting to technical or other obvious subterfuges in order to keep the application pending before the primary examiner, can no longer find a refuge in the rules to ward off a final rejection.

The examiner should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing, and that a clear issue between applicant and examiner should be developed, if possible, before appeal. However, it is to the interest of the applicants as a class as well as to that of the public that prosecution of an application be confined to as few actions as is consistent with a thorough consideration of its merits. Neither the statutes nor the Rules of Practice confer any right on an applicant to an extended prosecution; Ex parte Hoogendam, 1939 C.D. 3, 499 O.G.3, 40 USPQ 389 (Comm'r Pat. 1939).

STATEMENT OF GROUNDS

In making the final rejection, all outstanding grounds of rejection of record should be carefully reviewed, and any such grounds relied on in the final rejection

should be reiterated. They must also be clearly developed to such an extent that applicant may readily judge the advisability of an appeal unless a single previous Office action contains a complete statement supporting the rejection.

However, where a single previous Office action contains a complete statement of a ground of rejection, the final rejection may refer to such a statement and also should include a rebuttal of any arguments raised in the applicant's reply. If appeal is taken in such a case, the examiner's answer should contain a complete statement of the examiner's position. The final rejection letter should conclude with Form Paragraph 7.39.

MPEP 714.12 states:

Once a final rejection that is not premature has been entered in an application, applicant or patent owner no longer has any right to unrestricted further prosecution. This does not mean that no further amendment or argument will be considered. Any amendment that will place the application either in condition for allowance or in better form for appeal may be entered. Also, amendments complying with objections or requirements as to form are to be permitted after final action in accordance with 37 CFR 1.116(b). Ordinarily, amendments filed after the final action are not entered unless approved by the examiner. See MPEP § 706.07(f), § 714.13 and § 1207.

MPEP 714.13 states:

It should be kept in mind that applicant cannot, as a matter of right, amend any finally rejected claims, add new claims after a final rejection (see 37 CFR 1.116) or reinstate previously canceled claims.

OPINION

Petitioner seeks reversal of the Technology Center Director's decision of February 8, 2006, on the grounds that the final Office action of May 18, 2005, improperly rejected the claims over the prior art and that the amendment after final filed May 26, 2005 did not raise new issues that would require further search. Accordingly, petitioner further contends that the amendment filed May 26, 2005 should be entered.

Petitioner complains that the examiner has erred in not recognizing as to how the claims distinguish over the prior art. A rejection, or the continuation of a rejection, of a claim(s) cannot be reviewed on petition; rather, as explained in MPEP 1201, the mechanism for having the propriety of a given rejection reviewed is by way of appeal before the Board of Patent Appeals and Interferences under 35 U.S.C. § 134 and 37

CFR 41.31. The issues of whether e.g., the examiner properly analyzed the claims in light of the specification disclosure before making the rejection(s), or whether the rejections over prior art were properly maintained relate to the merits of those rejections and such can only be considered on appeal and will not be considered on petition. See 37 CFR 1.181(a); see also Boundy v. U.S. Patent & Trademark Office, 73 USPQ2d 1468 (DC Eva 2004), appeal dismissed, 2004 U.S. App. LEXIS 26384 (Fed. Cir. 2004). It is well settled that the Director will not, on petition, usurp the functions or impinge upon the jurisdiction of the Board of Patent Appeals and Interferences. See In re Dickerson, 299 F.2d 954, 958, 133 USPQ 39, 43 (CCPA 1962); Baylev's Restaurant v. Bailev's of Boston, Inc., 170 USPQ 43, 44 (Comm'r Pat. 1971).

Petitioner further argues the amendment of May 26, 2005 should be entered, as it did not raise new issues that require further search. Given that the Office action was properly made final, 37 CFR 1.116 is controlling on entry *vel non* of the amendment after final filed May 26, 2005. As explained MPEP §§ 714.12, 714.13 entry of the amendment was not a matter of right and, as here, could properly be refused entry by the examiner, for various reasons, including that a proposed amendment raises new issues that would require further consideration or search. In the Advisory Action of July 7, 2005, the examiner noted that the proposed amendment did not clearly place the application in condition for allowance and that the claims as proposed to be amended required further consideration or search.

Furthermore, the Technology Center Director correctly noted: (1) petitioner's contention that on March 1, 2005 an amendment was entered presenting claim 3 containing the language "...an elongated container with a top cover and a bottom cover and an attached strike plate..."; (2) that this language defines a container having these three elements and does not define any relation as to direct or indirect attachment of the strike plate to the container; (3) the proposed after final amendment submitted on May 26, 2005 contained the language "...an elongated container with a top cover and a bottom cover which has as attached strike plate..."; and (4) that this language adds new language requiring the strike plate be attached (directly or indirectly) to the bottom cover.

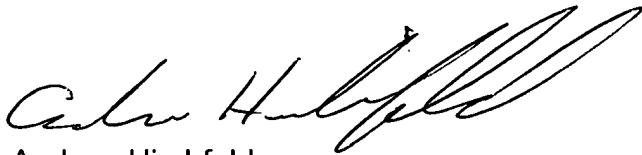
For the reasons set forth above, the Technology Center Director's decision to refuse petitioners' request to compel the entry of the amendment after final filed May 26, 2005 is not shown to be in clear error.

DECISION

A review of the record indicates that the Technology Center Director did not abuse his discretion or act in an arbitrary and capricious manner in the petition decision of February 8, 2006. The record establishes that the Technology Center Director had a reasonable basis to support his findings and conclusion.

The petition is granted to the extent that the decision of the Technology Center Director of February 8, 2006 has been reviewed, but is denied with respect to making any change therein. As such, the decision of February 8, 2006 will not be disturbed. The refusal to enter the amendment of May 26, 2005, will not be disturbed. The petition is **denied**.

Telephone inquiries concerning this decision should be directed to David A. Bucci at (571) 272-7099.

A handwritten signature in black ink, appearing to read "Andrew Hirshfeld", with a stylized, flowing script.

Andrew Hirshfeld
Acting Deputy Commissioner for
Patent Examination Policy

Cp

¹ This decision may be viewed as a final agency action within the meaning of 5 U.S.C. § 704 for purposes of seeking judicial review. See MPEP 1002.02